INDEX

CITATIONS

In the Supreme Court of the United States

OCTOBER TERM, 1947

No. 652

HAROLD E. EDGERTON, PETITIONER

v.

LAWRENCE C. KINGSLAND, COMMISSIONER OF PATENTS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA

BRIEF FOR THE RESPONDENT IN OPPOSITION

OPINIONS BELOW

The District Court of the United States for the District of Columbia did not write an opinion. Its informal memorandum, findings of fact, and conclusions of law appear at R. 27-29. The opinion of the United States Court of Appeals for the District of Columbia (R. 579-586) is reported at 75 U. S. P. Q. 307.

JURISDICTION

The judgment of the District Court was entered on April 16, 1946 (R. 30). The judgment of the Court of Appeals (R. 587) was entered December 4, 1947. A petition for rehearing was denied on January 6, 1948 (R. 588). The jurisdiction of this Court is invoked under Section 240(a)

of the Judicial Code, as amended by the Act of February 13, 1925.

QUESTION PRESENTED

In 1941 the Board of Appeals of the United States Patent Office affirmed a primary examiner's decision rejecting certain claims on the ground that they were not supported by the disclosure of the application. Other claims in the application for patent were still pending at that time and were not finally disposed of until more than three years later. After the final disposition of these remaining claims, the applicant brought a bill in equity under R. S. 4915, as amended (35 U. S. C. 63), to review the action of the Board of Appeals in rejecting various claims, including those which had been rejected in 1941, thus raising the following question:

Whether, as to the claims rejected in 1941, the six-month period within which a bill in equity to review that decision could be filed under R. S. 4915 ran from the date on which such claims were finally rejected, or from the date on which all claims in the patent application were finally disposed of.

STATUTES INVOLVED

The statutes involved, R. S. 4909, 4911 and 4915, as amended (35 U. S. C. 57, 59a and 63), are set forth in the Appendix, *infra*, pp. 12-13.

STATEMENT

Petitioner Harold E. Edgerton brought an equity proceeding in the District Court of the United States for the District of Columbia under R. S. 4915, as amended (35 U. S. C. 63), to obtain a judgment entitling him to the issuance of a patent containing claims 74, 76 to 81, and 222 of his application, No. 685,501 (R. 1-20).[1] Of these, only

[1] This suit was consolidated for trial (R. 64-65) with a similar suit relating to claims 12 and 14 (R. 49-59) and with a suit in the nature of a mandamus proceeding (R. 33-37) in which petitioner sought to compel respondent to allow certain amendments to the specification of his application, but these suits have no bearing on the issue presented here.

claims 74 and 76 to 81 are involved in the present petition (Pet. 13, 30).

Petitioner's application, filed in the Patent Office on August 16, 1933, was for a patent on a new and improved stroboscope, which is a means of producing intermittent or flashing light for viewing moving objects (R. 28, 207). The original application contained sixteen claims, but during the course of the examination of the application various amendments added a great many new claims and modified or cancelled prior claims (R. 221-224, 229-248, 500-501). While this application was pending two patents were issued to one Benjamin Miller for stroboscopic devices, and on June 11, 1937, the primary examiner declared an interference, identified as No. 74,402, between certain of petitioner's claims, including claims 74 and 76 to 81, and claims of the Miller patents (R. 249-255).

Interference No. 74,402 was later dissolved as to those counts which included petitioner's claims 74 and 76 to 81, these claims being

> * * * rejected on the ground that they are not readable on applicant's disclosure for the reason that he has not disclosed a "static inverter" as required by claims 74 and 76-81 * * *. (R. 259).

A large number of petitioner's claims were allowed (R. 261), but claims 74 and 76 to 81, the static inverter [2] claims, were finally rejected by the primary examiner on December 23, 1940, this rejection being affirmed by the Board of Appeals of the Patent Office on August 1, 1941 (R. 262, 272-274). On September 16, 1941 the Board of Appeals adhered to its decision on a petition for rehearing (R. 275-276). Thereafter petitioner requested a reconsideration of the Board's decision, stating that his application was not in

[2] An explanation of the term "static inverter" is found at R. 182-183. It should be noted, however, that for the purposes of this brief it is not necessary to discuss the meaning of this term.

condition for review by the courts owing to the pendency of another interference (R. 277-278). This request was refused (R. 280) and, when it was renewed, it was refused again[3] on December 17, 1941 with the following comment:

> • • • Appellant's suggestion that the limit of appeal will not expire until the interference in which the present application is involved is terminated and after a long period of further *ex parte* prosecution has elapsed is not convincing to us (R. 281).

Ex parte action on the application was resumed when the second interference was terminated, and on March 24, 1943 the claims here involved were refused further consideration on the ground that the previous final rejection of them was *res judicata* as the time for further appeal had expired (R. 286, 500). This ruling was affirmed by the Board of Appeals on January 1, 1945 (R. 511-513, 516), and after making various efforts to obtain a reversal of this ruling in the Patent Office,[4] petitioner instituted the present proceeding in the United States District Court for the District of Columbia on June 1, 1945.

After a hearing the District Court filed an informal memorandum, findings of fact, and conclusions of law rejecting the static inverter claims not only on the ground that they were barred by the principle of *res judicata* because of petitioner's failure to file either an appeal to the United States Court of Customs and Patent Appeals or a complaint under R. S. 4915 within the time allowed, but also on

---

[3] Petitioner thereafter requested the primary examiner to take further action on claims 74 and 76 to 81, which request was refused, and a petition for supervisory action was likewise denied by the Assistant Commissioner of Patents (R. 284, 285).

[4] On request for reconsideration the Board of Appeals adhered to its decision with regard to the claims here involved, though it reversed its decision as to other claims (R. 517-520). A petition to respondent Commissioner of Patents to overrule the rejection of these claims was denied (R. 521-524, 547-548).

the ground that they were not supported by the disclosure of petitioner's application, the ground on which they were originally rejected by the primary examiner and the Board of Appeals (R. 27-29, 259, 262, 272-274). On April 16, 1946 the District Court entered judgment dismissing petitioner's complaint (R. 30). On appeal the Court of Appeals for the District of Columbia considered it necessary to discuss only the *res judicata* question, and affirmed the District Court on that ground on the authority of this Court's decision in *Hoover Co.* v. *Coe,* 325 U. S. 79, which was deemed to be controlling (R. 582-583, 586).

ARGUMENT

The sole question presented by the petition herein is whether, under R. S. 4915, as amended (35 U. S. C. 63), a patent applicant must bring his bill in equity within six months after each separate final decision in the Patent Office involving one or more claims in his application, or whether the applicant may wait until after a final decision upon all the claims in the application and then bring his bill in equity within six months of such final decision (Pet. 2). We submit that in ruling that the equity proceeding must be brought within six months after the final refusal by the Patent Office of any claim the court below correctly interpreted R. S. 4915 and properly applied the decision of this Court in *Hoover Co.* v. *Coe,* 325 U. S. 79, and that, in any event, the petitioner has failed to show that the rejection of his static inverter claims by the primary examiner, the Board of Appeals, and the District Court was clearly erroneous.

1. Petitioner relies entirely on the general rule that the piecemeal disposition on appeal of a single controversy is not permissible (Pet. 15-24). In this context petitioner, conceding that an applicant's right to a judicial determination of the question as to whether he is entitled to a patent

is based solely on R. S. 4915,[5] urges an interpretation of that statute which would prohibit a patent applicant from resorting to a bill in equity after an adverse final decision in the Patent Office on any individual claim, and would make this relief available to him only after there has been a final decision as to all his claims (Pet. 24-28). However, as the court below pointed out (R. 582), that statute has already been construed by this Court adversely to petitioner's contention in *Hoover Co.* v. *Coe*, 325 U. S. 79.

In the *Hoover Co.* case an applicant for a reissue of a patent included in his application a number of claims copied from later patents in order to provoke interferences therewith. The decision of the primary examiner rejecting four of the claims as not reading on applicant's disclosure was affirmed by the Board of Appeals of the Patent Office. The applicant then brought suit against the Commissioner of Patents under R. S. 4915, and the complaint was dismissed by the District Court on the ground that the claims did not read on the disclosure. The Court of Appeals for the District of Columbia dismissed the appeal on its own motion, holding that since the District Court could not enter a decree authorizing the issuance of a patent because of the impending interference proceeding, a court of equity ought not to afford piecemeal relief pending completion of the administrative process and therefore ought not to entertain a suit under R. S. 4915 unless its adjudication would conclude all possible questions as to the right to a patent. This Court reversed that ruling, holding that the decision of the Board of Appeals finally denied a patent on the claims presented and so was like a dismissal of a suit in court, and that under R. S. 4915 the applicant could sue to correct error in that dismissal.

---

[5] On an appeal to the Court of Customs and Patent Appeals under R. S. 4911 that court acts in an administrative capacity on the Patent Office record, and its decision cannot be reviewed in this or any other court. *Postum Cereal Co.* v. *California Fig Nut Co.*, 272 U. S. 693, 699.

Petitioner seeks to distinguish *Hoover Co.* v. *Coe* on the ground that in that case there had been a final decision by the Patent Office upon all the claims in controversy, and hence the action of the Court of Appeals for the District of Columbia had been a misapplication of the rule prohibiting piecemeal review (Pet. 28-29). However, there is nothing in this Court's opinion to indicate that in that case all claims had been disposed of prior to the bringing of the suit,[6] or that the final disposition of all claims was considered by this Court as a condition precedent to the bringing of the suit. Instead, this Court pointed out that the right of appeal to the United States Court of Customs and Patent Appeals under R. S. 4911 (35 U. S. C. 59a) and the right to bring a bill in equity under R. S. 4915 (35 U. S. C. 63) in a federal district court are alternative rights of review accorded a patent applicant, and then said (325 U. S. at 83-84):

> The question is whether the differences in the character of the proceedings and the statutory effect of decision or adjudication require a holding that as to all decisions on the merits adverse to the applicant, other than the final action as to the issue of a patent, the applicant must obtain review by appeal to the Court of Customs and Patent Appeals, and can proceed by bill under R. S. 4915 only when every step requisite to issue has been taken. If so, the language of R. S. 4915 is ill chosen. * * *

Petitioner has apparently failed to grasp the full significance of this Court's holding that a final decision in the Patent Office may be reviewed by bill in equity under R. S. 4915 whenever the same decision could be reviewed on

---

[6] Even an examination of the record in *Hoover Co.* v. *Coe*, No. 486, October Term, 1944, sheds little light on this point. The ruling of the primary examiner (pp. 113-115) rejecting the claims as to which suit was brought shows the disposition made of 31 of a total of 41 claims, but there is nothing to indicate whether the remaining 10 claims (claims 24 to 33, inclusive) had been cancelled or previously rejected, or were still pending.

appeal to the Court of Customs and Patent Appeals under R. S. 4911. R. S. 4911 gives "* * * any applicant * * * dissatisfied with the decision of the board of appeals * * *" the right to appeal to the Court of Customs and Patent Appeals. With regard to the matters which may be taken to the Board of Appeals, R. S. 4909 provides:

> Every applicant for a patent or for the reissue of a patent, *any of the claims of which have been twice rejected,* may appeal from the decision of the primary examiner to the Board of Appeals, having once paid the fee for such appeal. [Italics supplied.]

Thus the statutes clearly provide that the rejection of any claim in a patent application may be appealed to the Board of Appeals, and any decision of the Board of Appeals may be appealed to the Court of Customs and Patent Appeals, and as a matter of practice that court has entertained appeals in cases in which all claims had not been finally disposed of in the Patent Office. *In re Gillam,* 37 F. 2d 959; *In re Rundell,* 55 F. 2d 450; *In re Robertshaw,* 75 F. 2d 203. Since the remedies under R. S. 4911 and 4915 are alternative remedies, it follows that the rejection of any claim in a patent application gives the applicant a right to a judicial determination on a bill in equity as to whether he is entitled to a patent which includes such claim, without the necessity of waiting until there had been a final disposition of all claims.

Petitioner asserts that the Patent Office has heretofore construed R. S. 4915 in a way inconsistent with its present position, citing *Ex parte King,* 366 Official Gazette 3, an opinion rendered by Acting Commissioner Kinnan in 1927 (Pet. 26-27, 31-34). That opinion, however, purports to be no more than a construction of the Patent Office's Rule 139, and is simply a determination by the Commissioner of Patents as to the time when certain decisions of the Board

of Appeals shall be considered final. But even if it were true that in 1927 the Patent Office had construed R. S. 4915 in accordance with petitioner's present contention, that construction had obviously been changed in 1941, when the Board of Appeals rendered its final decision as to petitioner's static inverter claims. At that time the Board rejected as "not convincing" petitioner's suggestion that his time for appeal from its decision would not expire until the termination of an interference in which his application was then involved (R. 281). Petitioner was thus put on notice that, at least in the view of the members of the Board of Appeal, the period of six months within which he must seek a review of that decision by a bill in equity under R. S. 4915 was reckoned from the date of the decision.

Petitioner's contention (Pet. 26) that the term "his claim" in R. S. 4915 means "all claims," so that an equity action would lie only after a final rejection of all claims in the application, ignores the fact that under R. S. 4915 a bill in equity will lie to determine whether the "• • • applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim *or for any part thereof*, as the facts in the case may appear" [Italics supplied]. This indicates that the controversy presented may be the validity of only a part of the subject matter of the entire application. The words "as specified in his claim, or for any part thereof" originated in Section 16 of the Patent Act of 1836, c. 357, 5 Stat. 117, 123-124. Under the practice then prevailing, there was only one claiming paragraph, sometimes called the "claim" or the "claiming part," and when more than one claim was made in an application, they were included in the claim paragraph separated only by a phrase such as "I also claim." Thereafter, the current practice evolved of inserting separate claims in separately numbered paragraphs. See Lutz, *Evolution of the Claims of United States Patents*, 20 Journ. Pat. Off. Soc. 457, 469.

Hence the words "as specified in his claim or for any part thereof" refer to all the claims in the application or to any one of them. The cases cited by petitioner (Pet. 26) as construing the words "his claim" in R. S. 4915 to mean "all the claims" are suits for patent infringement which did not involve R. S. 4915 and in which that statute is not even discussed. We submit, therefore, that the court below properly applied the decision of this Court in *Hoover Co.* v. *Coe*, 325 U. S. 79, and was correct in holding that under R. S. 4915 a final decision of the Board of Appeals rejecting any claim in a patent application was *res judicata* as to that claim, where no appeal was taken to the Court of Customs and Patent Appeals and where the applicant did not bring a bill of equity in a district court within six months, even though there were other claims still pending in the Patent Office.

2. It should be noted that, in so far as petitioner is concerned, the question of the correct interpretation of R. S. 4915 is academic, as petitioner has made no showing that he is entitled to relief on the merits. Petitioner's static inverter claims were rejected by the primary examiner and the Board of Appeals on the ground that they were not readable on the disclosure of his application, a purely factual issue. The reasons why the claims did not read on the disclosure are set forth in the Board of Appeals' decision of September 16, 1941, on petition for rehearing (R. 275-276). Although petitioner charges that the Patent Office's lack of familiarity with the art was responsible for these rulings, and complains that he was not allowed to present certain testimony supporting his claims until the trial of this cause in the District Court (Pet. 8), he neglects to mention that after a full hearing the District Court also found that the disclosure in the application did not support any of the claims here involved and dismissed petitioner's

suit on that ground as well as on the ground that the Board of Appeals decision on these claims had become *res judicata* (R. 29). Although this ground of decision was not considered by the court below on the appeal, in the review of proceedings under R. S. 4915 that court has consistently applied the well-established rule that findings of fact of the trial court will not be disturbed unless clearly erroneous or without support in the evidence. *Abbott* v. *Coe,* 109 F. 2d 449, 451; *Forward Process Co.* v. *Coe,* 116 F. 2d 946, 947; *Minnesota Mining & Mfg. Co.* v. *Coe,* 118 F. 2d 593, 594, certiorari denied, 314 U. S. 624; *General Motors Corporation* v. *Coe,* 120 F. 2d 736, 737, certiorari denied, 314 U. S. 688; *Sharp* v. *Coe,* 125 F. 2d 185. This rule has peculiar force where, as here, the contested finding has been concurred in by both the Patent Office and the District Court. *Abbott* v. *Coe, supra* at p. 452; cf. *United States* v. *Commercial Credit Co., Inc.,* 286 U. S. 63, 67.

CONCLUSION

The decision below is correct and there is no conflict of decisions. It is, therefore, respectfully submitted that the petition for writ of certiorari should be denied.

PHILIP B. PERLMAN,
Solicitor General.
H. G. MORISON,
Assistant Attorney General.
PAUL A. SWEENEY,
ALVIN O. WEST,
Attorneys.

W. W. COCHRAN,
Solicitor.
E. L. REYNOLDS,
Attorney,
United States Patent Office.

March, 1948

APPENDIX

Revised Statutes 4909, 4911 and 4915, as amended (35 U.S.C. 57, 59a and 63), provide as follows:

SEC. 4909. Every applicant for a patent or for the reissue of a patent, any of the claims of which have been twice rejected, may appeal from the decision of the primary examiner to the Board of Appeals, having once paid the fee for such appeal.

SEC. 4911. If any applicant is dissatisfied with the decision of the board of appeals, he may appeal to the United States Court of Customs and Patent Appeals, in which case he waives his right to proceed under section 4915 of the Revised Statutes. [U.S.C., title 35, sec. 63.] If any party to an interference is dissatisfied with the decision of the board of interference examiners, he may appeal to the United States Court of Customs and Patent Appeals, provided that such appeal shall be dismissed if any adverse party to such interference shall, within twenty days after the appellant shall have filed notice of appeal according to section 4912 of the Revised Statutes [U.S.C., title 35, sec. 60], file notice with the Commissioner of Patents that he elects to have all further proceedings conducted as provided in section 4915 of the Revised Statutes. Thereupon the appellant shall have thirty days thereafter within which to file a bill in equity under said section 4915, in default of which the decisions appealed from shall govern the further proceedings in the case.

SEC. 4915. Whenever a patent on application is refused by the Board of Appeals or whenever any applicant is dissatisfied with the decision of the board of interference examiners, the applicant, unless appeal has been taken to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under this section, may have remedy by bill in equity, if filed within six months after such refusal or decision; and the court having cognizance thereof, on notice to

adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. In all cases where there is no opposing party a copy of the bill shall be served on the commissioner; and all the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not. In all suits brought hereunder where there are adverse parties the record in the Patent Office shall be admitted in whole or in part, on motion of either party, subject to such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court may impose, without prejudice, however, to the right of the parties to take further testimony. The testimony and exhibits, or parts thereof, of the record in the Patent Office when admitted shall have the same force and effect as if originally taken and produced in the suit.

U. S. GOVERNMENT PRINTING OFFICE, 1948